

REMARKS

Claims 67-96 were pending. The Examiner rejected claims 67-96. Applicants have herein cancelled claims 69-70, 79-80, 83-84, and 93-94; amended claims 67-68, 71-74, 81-82, 85-88, and 95-96; and added claims 97 and 98. Support for the amendments and new claims can be found throughout the Specification, *e.g.*, at page 9, lines 1-13; page 10, lines 1-29; page 24; page 25, lines 1-5; page 31; page 33, lines 25-30; page 34, lines 1-12; page 37; page 39, lines 6-22; page 42, lines 1-7; page 55; page 57; page 62; and page 63. No new matter has been added. Applicants respectfully request reconsideration and allowance of the pending claims in light of the amendments and remarks herein.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 67-96 as failing to comply with the written description requirement, specifically stating that the claims were not described adequately in the Specification such that a person skilled in the art would recognize that the inventors were in possession of the claimed invention at the time of filing. In addition, the Examiner asserted that various limitations in the claims were not described in the Specification.

With respect to the rejection of claims 67 and 81, the Examiner stated that “the limitation that the MS moiety ‘comprises an amide bond’ was not described in a reasonably generic manner to include this large genus encompassed thereby.” Applicants respectfully disagree. The present specification provides adequate written description of an MS moiety comprising an amide bond; *see, e.g.*, pages 9, 31, 33, 34, 42, and 62. In order to further prosecution, however, Applicants have herein amended claims 67 and 81 to recite that the MS is an amide bond, thereby obviating the Examiner’s rejection. In addition, Applicants have herein amended claims 67 and 81 to recite that the MM moiety is a peptide that consists of two or three amino acids. Claims 68 and 82 have been amended to recite that the MM consists of two Arg, Lys, or tm-Lys amino acids, or mixtures thereof. Applicants reserve the right to pursue broader claims, particularly with respect to the scope of the MS and/or MM moiety, in continuation applications.

In light of the above, Applicants request withdrawal of the rejections of claim 67-96.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 67-96, asserting that the claims were indefinite. In particular, the Examiner asserted that the structures set forth in the claims were confusing.

Applicants respectfully disagree with respect to the amended claims. Present claims 67 and 81 have been amended to include a linker moiety, L, to reflect the attachment between [IEM-PBM]- and -[MS-MM] functionalities. Support for such a group and its positioning is provided in the Specification at page 9, lines 1-13, and at page 10. In addition, Applicants have amended the claims per the Examiner's suggestion to clarify the stoichiometry of the -[MS-MM] moiety by including the "p" subscript; *see e.g.*, page 10, lines 5-19.

Applicants have amended claim 81 to provide a chemical structure for the composition, rather than provide a generic formula for the composition. Applicants respectfully assert that the amended claim is neither confusing nor contradictory. Finally, chemical structures have been included in claims 96 per the Examiner's suggestion, and in new claim 98. Applicants respectfully point out to the Examiner that the L structure set forth in claim 98 corresponds to the L group as set forth in Prodrug Compound 2, given that the C-N amide linkage between Gly and Ile is defined as the MS herein.

Given all of the above, Applicants respectfully request withdrawal of the rejections of claims 67-96.

Applicant : Randall B. Lauffer et al.
Serial No. : 10/758,729
Filed : January 16, 2004
Page : 14 of 14

Attorney's Docket No.: 13498-019003 / MET-
5/Continuation

CONCLUSION

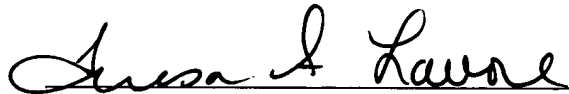
Applicants respectfully assert that all claims are in condition for allowance, which action is requested. The Examiner is invited to telephone the under-signed attorney if such would expedite prosecution.

Pursuant to 37 CFR §1.136, Applicants hereby petition that the two-month period for response to the action dated August 1, 2005, extends to October 3, 2005, as October 1, 2005 was a Saturday.

Enclosed is a \$360.00 check for multiple dependent claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 10/3/05


Teresa A. Lavoie, Ph.D.
Reg. No. 42,782

Fish & Richardson P.C., P.A.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

60317499.doc